

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hasan Khatib

Conf. No.: 5115

Application No.: 10/726,571

Group Art Unit: 1634

Filed: December 4, 2003

Examiner: Cho, Dan Sung C

For: METHOD AND COMPOSITIONS FOR
GENETICALLY DETECTING IMPROVED
MILK PRODUCTION TRAITS IN CATTLE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed August 17, 2006, applicant hereby provisionally elects Group II, claims 12-21, 25, 28 and 29 for examination on the merits, with traverse.

Applicant gratefully notes that the Office Action has acknowledged that certain claims in the other two Groups are properly rejoinable with the claims elected for examination.

In response to the "restriction" requirement detailed in paragraphs 4-9 of the Office Action, applicant elects the "combination" of all SNPs at position 164, as described in the specification. The election is made with traverse.

Although an election of species request may be proper under the circumstances, the requirement as explained in the Office Action does not appear to be such a request. There is,

however, no justification in limiting the claims under examination to only one of the so-called “combinations.” The Office Action in paragraphs 4-9 has provided no explanation why such a limitation is justified, other than providing a quotation, entirely out of context, from the MPEP § 803.4 that “applicants will required to select one combination for examination.” The “combination” discussed in the MPEP refers to the combination of different nucleic acid *molecules*. In contrast, the “combination” relevant to the subject matter of the present claims are different nucleotides of the *same molecule* that encodes the same protein molecule. In fact, the same section of the MPEP specifically states that

It has been determined that normally *ten sequences* constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. *Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.*

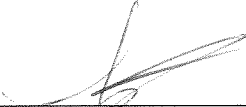
MPEP § 803.4 (emphasis added). Accordingly, the attempt by the Office Action to limit the subject matter under examination to only one of the 5 polymorphic nucleotide sites of the same nucleic acid molecule is entirely unreasonable and cannot be justified in anyway.

Withdrawal of this requirement is thus respectfully requested.

Applicant believes no fee is due with the response. However, the Director is hereby authorized to charge any fee deficiency Deposit Account No. 11-0553, under Order No. 2901803.3.

Dated: September 18, 2006

Respectfully submitted,

By 
Kening Li, Ph.D.

Registration No.: 44,872
BAKER DONELSON BEARMAN CALDWELL &
BERKOWITZ, PC
555 11th Street, NW
6th Floor
Washington, DC 20004
Customer No. 59554
(202) 508-3450
(202) 508-3402 (Fax)
Attorneys for Applicant